

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/805,185

REMARKS

Claims 1-7 have been examined. Claims 1, 2, 4, and 6 have been amended. Claims 8-11 have been added.

Preliminary Matters

The Examiner asserts that the information disclosure statement (IDS) filed on March 14, 2001, fails to comply with 37 C.F.R. § 1.98(a)(1). In addition, the Examiner asserts that Application No. 09/639,161 is not a proper reference for an IDS, since the application is not a published document. Applicant respectfully disagrees.

Applicant respectfully submits that an information disclosure statement filed under 37 C.F.R. § 1.97 shall include the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office (See 37 C.F.R. § 1.98(a)(1)); and (2) a legible copy of each pending U.S. Application (See 37 C.F.R. § 1.98(a)(2)(iii)).

Accordingly, Applicant submits that the IDS filed March 14, 2001, properly disclosed pending U.S. Application No. 09/639,161. In addition, as indicted in the IDS, a copy of the document was submitted, together with the IDS. Therefore, Applicant has complied with 37 C.F.R. § 1.98 and the Examiner should consider the U.S. application submitted in the subject IDS.

Claims

Claims 1, 2, 4, and 6 are amended to define more clearly Applicant's invention and to place the claims in better form for examination under U.S. practice. Applicant notes that these amendments are not believed to narrow the scope of the claims.

Allowable Subject Matter

Claim 6 is rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant notes that, since original claim 6 was a multiple dependent claim, rewritten claim 6 includes only subject matter from claim 1. In addition, with respect to the dependency of claim 6 from claims 2-5, Applicant respectfully adds new claims 8-11 to include this subject matter.

Claim Rejections under 35 U.S.C. § 103(a)

I. Claims 1, 2, 3, 4, and 5:

The Examiner rejects claims 1, 2, 3, 4, and 5 under 35 U.S.C. § 103(a) as being obvious over Barbera et al. (U.S. Patent No. 6,364,556).

Barbera relates to a transmissible paper sensor including a light beam projector and a light detector for detecting the presence of a print medium in the field of view of the paper sensor. Barbera concerns itself with the problem of detecting overlapped print media as being different than a single sheet. See, e.g., col. 1, lines 36-39. In particular, Barbera teaches an upper arm 203 and a lower arm 205 on opposite sides of a paper path. See col. 4, lines 4-16. A light emitting diode (LED) 207 is mounted on the upper arm 203 and a photo-receptor 211 is mounted on the lower arm 205. The photo-receptor 211 is in visual alignment with the LED 207 for detecting the light beam projected across the paper path.

The Examiner asserts that it would have been obvious to reverse the parts of Barbera, i.e., placing the LED 207 on the lower side of the paper path, and that this configuration would work equivalently to its original configuration. For the following reasons, Applicant traverses these rejections.

Applicant's invention defines an insertion platform for an image transfer apparatus. In particular, a part or a whole of the insertion platform for the image transfer apparatus includes a member that is operable to allow light to be transmitted from the lower side of the insertion platform. Among other things, since the insertion platform is illuminated from the lower side and the image receiving plate is superimposed on the upper surface of the insertion platform, the image receiving sheet is illuminated by the light from the lower side and match-marks of the image receiving sheet can be visually confirmed from above the transfer sheet. Thus, accurate positioning can be quickly and easily performed. Further, the positioning of a small sized image receiving sheet, which is placed under a larger sized transfer sheet, can be simply and correctly conducted.

Applicant submits that it would not have been obvious to modify Barbera in order to arrive at the claimed combination. In particular, Barbera does not recognize that an operator of the machine would have a need to align an image receiving sheet and a transfer sheet, and therefore, modifying Barbera to permit the paper to be viewed from above would not have been obvious to a person of ordinary skill in the art.

Further, Applicant respectfully submits that the Examiner has not provided any motivation or suggestion, either explicitly or inherently, for modifying Barbera to arrive at

Applicant's claimed combination. In particular, the Examiner has merely asserted that, if the parts of Barbera were reversed, Barbera still would work equivalently to its original configuration. Thus, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness, since the Examiner has not provided any motivation or suggestion for modifying Barbera to arrive at the claimed combination.

In addition, it is settled law that the mere fact that a reference can be modified does not render the claimed combination obvious unless the prior art also suggests the desirability of the modification. Therefore, the Examiner's mere assertion that Barbera can be modified also does not satisfy the requirements for establishing a *prima facie* case of obviousness.

Moreover, it is settled law that the proposed modification cannot render the cited reference unsatisfactory for its intended purpose, nor can the proposed modification change the principle of operation of a reference. Yet a substantial reconstruction and redesign of the elements of Barbera, as well as a change in the basic principle under which Barbera was designed to operate, would be necessary to arrive at the claimed combination. That is, the device of Barbera would have to be reconfigured, for example, such that the LED would be disposed at an external position to the device 123, instead of an internal position, as shown in Figures 1 and 2 of Barbera.

Moreover, Applicant submits that there would not have been a reasonable expectation of success for modifying Barbera in order to arrive at the claimed combination. In particular, Barbera teaches using an LED to project light across a paper path. Therefore, an LED, which provides a light beam across the paper path (see col. 4, lines 5-6), would operate to illuminate

only a point of light, rather than a surface area of an insertion platform sufficient for viewing the alignment of the transfer and receiving sheets. Moreover, Barbera uses the optical beam for detecting the status at the printing media path, such as non-printing media, a single sheet, or a plurality of sheets. On the contrary, in the present invention light is projected from a lower position through the insertion platform so that the operator can visually confirm the alignment and proper arrangement of the receiving sheet and transfer sheet. For at least these reasons, Applicant submits that there would not have been a reasonable expectation of success for modifying Barbera to arrive at the claimed combination, and therefore, a *prima facie* case of obviousness has not been established.

Further, Applicant submits that, even if a person of ordinary skill in the art would have been motivated to modify Barbera, the modification would not teach or suggest all of the recitations of claim 1.

For the foregoing reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness, and therefore, the rejection of claim 1 should be withdrawn. In addition, claims 2-5 also are not obvious over Barbera at least by virtue of their dependency from claim 1, and therefore, the rejection of these claims also should be withdrawn.

II. Claim 4:

The Examiner rejects claim 4 under 35 U.S.C. § 103(a) as being obvious over Barbera and Murazaki et al. (U.S. Patent No. 5,859,496). For the reasons set forth above with respect to claim 1, Barbera does not teach or suggest all of the recitations of independent claim 1.

Moreover, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

In addition, Applicant submits that Murazaki, which relates to an afterglow lamp, does not make up for the deficiencies of Barbera with respect to claim 1. Thus, claim 4 is not obvious over the combination of Barbera and Murazaki at least by virtue of its dependency from claim 1, and accordingly, the rejection of claim 4 also should be withdrawn.

II. Claim 7:

The Examiner rejects claim 7 under 35 U.S.C. § 103(a) as being obvious over Barbera and Takekoshi (U.S. Patent No. 6,120,199). For the reasons set forth above with respect to claim 1, Barbera does not teach or suggest all of the recitations of independent claim 1. Moreover, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

In addition, Applicant submits that Takekoshi does not make up for the deficiencies of Barbera with respect to claim 1. Thus, claim 7 is not obvious over the combination of Barbera and Takekoshi at least by virtue of its dependency from claim 1, and accordingly, the rejection of claim 7 also should be withdrawn.


In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/805,185

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860


John J. Dresch
Registration No. 46,672

Date: October 21, 2002



AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/805,185

APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

1. (Amended) An insertion platform for an image transfer apparatus in which an image receiving sheet on which an image is formed, and a transfer sheet onto which an image is to be transferred, are superimposed on each other, and is sent into a heat roller pair inside the image transfer apparatus to heat and press the sheets, wherein at least a part of said insertion platform comprises a light transmission member operable to allow transmission of light from a lower side of said insertion platform[the insertion platform for an image transfer apparatus is characterized in that a part or the whole of the insertion platform is structured by a member provided with a function to transmit the light from the lower side].

2. (Amended) The insertion platform for an image transfer apparatus according to Claim 1, wherein the light transmission [function] member is any one of a transparent portion, translucent portion, light diffusion portion, or opening portion.

4. (Amended) The insertion platform for an image transfer apparatus according to Claim 2, wherein a light accumulation fluorescent substance is coated on at least one of the light transmission [function] member and[and/or] its periphery.

RECEIVED
OCT 28 2002
TECHNOLOGY CENTER 2850

6. (Amended) An insertion platform for an image transfer apparatus in which an image receiving sheet on which an image is formed, and a transfer sheet onto which an image is to be transferred, are superimposed on each other, and is sent into a heat roller pair inside the image transfer apparatus to heat and press the sheets, the insertion platform for an image transfer apparatus is characterized in that a part or the whole of the insertion platform is structured by a member provided with a function to transmit the light from the lower side, [The insertion platform for an image transfer apparatus according to any one of Claims 1 to 5,]

wherein the insertion platform for an image transfer apparatus is provided with a cutout having a length in which the operator can continue to have the leading edge of both sheets in the superimposed condition until it is nipped.

Claims 8-11 are added as new claims.